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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/516,648
Filing Date: March 01, 2000
Appellant(s): HOFFMAN, ROGER P

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Philip Weiss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 2, 2005 appealing from the Office action mailed June 1, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,913,773	KNUDSEN et al	04-1990
4,898,752	CAVAGNA et al	02-1990
4,254,173	PEER Jr.	03-1981
3,982,056	HOLDER Jr.	09-1976
3,603,501	CONFER	09-1971

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The rejection of claims 8 and 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome.
2. Claims 1-4, 7-10, 12, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173).

Cavagna teaches outer packaging paper materials are typically made of paperboard comprising unbleached kraft paperboard that has been surface treated on at least one side with a white coating or the like. The white coating may be applied as a thin layer of high quality label paper (col 1, lines 10-29).

Cavagna does not teach that the paperboard should further comprise a top ply overlying said white layer. However, Peer teaches a plastic film that can be applied to the exterior facing surface of outer packaging paper materials. The plastic film provides tear resistance to the composite and may be reverse printed (abstract). The plastic film is selected from the group consisting of polyethylene, polypropylene, and PET (abstract). Thus, it would have been obvious to one of ordinary skill in the art to apply the adhesive/plastic layer taught in Peer to the outer packaging taught in Cavagna. The motivation for doing so would have been to improve the tear resistance of the packaging.

With respect to claim 3, Cavagna does not explicitly teach what materials may be utilized in the production of the paperboard layer. However, Peer teaches that outer

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packaging is usually made from kraft pulp or recycled paper pulp (col 5, lines 11-50).

Thus, it would have been obvious to one of ordinary skill in the art to make the paperboard taught in Cavagna from either virgin kraft pulp or recycled pulp because Peer teaches said materials are traditionally used in the production of outer packaging.

With respect to claim 2, the examiner takes the position that the graphics produced using the adhesive/polymer overlay taught in Peer are “high quality” since they are sufficient for consumer appeal. The examiner further takes the position that the polymer ply taught in Peer meets the “enhanced smoothness” limitation of claim 6 because Peer teaches the top ply should be smooth (col 3, line 20). The examiner also takes the position that any adhesion would meet the “barrier for moisture, oil and odor” limitation of claim 7 because any substance will restrict moisture, oil, and odor transmission to some extent.

The examiner takes the position that the laminate taught in Cavagna meets the limitations of claim 4. Specifically, Cavagna teaches a paperboard coated with a “thin” paper layer. It is further noted that “paperboard” is generally understood to refer to cellulose fiber materials that are thicker than paper (see definition of “paperboard” from Merriam Webster’s Collegiate Dictionary).

With respect to claim 8, the examiner takes the position that the label grade paper taught in Cavagna is a publication grade paper. In support of said position, the examiner relies upon Appellant’s disclosure on page 11 of the specification (last paragraph) wherein label grade papers are listed as a type of publication grade paper.

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3. Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13.

Cavagna in view of Peer is relied upon as above, but neither reference teaches that the label paper should have a brightness of above 60ISO. However, it is known in the art to increase the brightness of a printing/imaging paper in order to enhance the image clarity. The courts have held that "When the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Thus, it would have been obvious to one of ordinary skill in the art to increase the brightness of the label paper taught in Cavagna in order to enhance the image clarity of the resulting secondary package material.

4. Claim 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13, and further in view of Holder Jr. (US 3,982,056).

Cavagna in view of Peer is relied upon as above, but does not teach that the label paper may be coated with clay, protein, starch, or titanium dioxide. However, Holder Jr. teaches that label papers have conventionally had a liquid coating composition applied to one surface in order to improve the printable characteristics of the paper (col 1, lines 7+). Such coating compositions include starch, clay, casein, and TiO_2 . Thus, it would have been obvious to one of skill in the art to apply any of clay,

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casein, TiO₂, or starch to the surface of the label paper taught in Cavagna in order to improve its printability.

5. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above.

Cavagna in view of Peer is relied upon as above. Specifically, Peer teaches that the plastic layer provides the laminate with an "attractive appearance" (col 8, lines 53+) but does not teach that the tear resistant film may be pigmented. However, the court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. (In re Seid , 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Thus, the examiner takes the position that it would have been obvious to one of ordinary skill in the art to apply pigment to the tear resistant film taught in Peer in order to obtain the desired aesthetic effect.

6. Claims 15 and 17-19 stands rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above, and further in view of Confer (US 3,603,501).

Cavagna in view of Peer is relied upon as above. Cavagna teaches that the paperboard core may be finished on both surfaces with a label paper (col 1, line 20). The examiner takes the position that an inner label paper would read on the claimed moisture absorbent layer. Cavagna does not teach that such label papers are adhered to the paperboard core. However, Confer teaches that secondary packaging materials

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are generally made by adhering the label paper to the paperboard core (col 3, lines 1-20). Thus, it would have been obvious to one of ordinary skill in the art to apply adhesive between the label paper and the paperboard core taught in Cavagna because Confer teaches that such a laminating technique is the traditional method by which secondary packaging is processed. With regard to claim 18, the examiner takes the position that any adhesive will act as a barrier to moisture to some extent.

7. Claims 15-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4, 7-10, 12, and 13 above, and further in view of Knudson et al. (US 4,913,773).

Cavagna in view of Peer is relied upon as above, but neither reference teaches that the paperboard core may comprise more than one layer of paperboard. However, Knudson teaches a multi-ply paperboard comprising one ply of high bulk fibers sandwiched between at least two plies of conventional papermaking fibers (abstract). A bonding agent may be utilized between the layers (col 5, lines 3-17). Said paperboard has superior stiffness in comparison to traditional paperboard. Stiffness is important in folding carton applications (col 3, lines 3-5). Thus, it would have been obvious to one of ordinary skill in the art to utilize the multiply paperboard taught in Knudson in place of the paperboard layer of the laminate taught in Cavagna. The motivation for doing so would have been to increase the stiffness of the laminate.

With respect to claims 15-19, the examiner takes the position that the second and third layers of the multiply paperboard read on the claimed unbleached pulp and

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absorbent layer, respectively. The bonding layer reads on the claimed moisture barrier layer.

(10) Response to Argument

Appellant's arguments have been fully considered but are not persuasive.

Appellant argues the combination of Cavagna and Peer does not render obvious a two-ply base layer having a layer of paper or film attached to the top ply. If anything, appellant argues the proposed combination would have led one of ordinary skill in the art to adhere the film of Peer to the unbleached paperboard layer of the laminate taught in Cavagna. Said argument has been fully considered but is not persuasive. Peer teaches the film layer should be adhered to the surface of the paper substrate "which is intended to be outwardly facing in the.... packaging application (col 4, lines 36+)."

Cavagna teaches the white kraft paper is applied to the unbleached paperboard stock so that the packaging may be printed (col 1, lines 10-29). Based upon said disclosure, the kraft paper is understood to be applied to the outwardly facing side of the package since one of ordinary skill in the art would want said printing on the side of the package visible to the consumer. Therefore, the examiner maintains the position that the combination of Cavagna and Peer would render obvious the claimed invention wherein the tear-resistant film layer is adhered to the top kraft paper ply. Furthermore, the examiner notes the claims are not limited to laminates wherein the film layer is "directly" adhered to the top ply of the laminate. Thus, in arguendo, a laminate wherein said tear-

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resistant film layer is adhered to the unbleached layer of laminate taught in Cavagna would render obvious the claimed invention.

Appellant further argues there is nothing in Cavagna that would have suggested the need for a further layer to help with the tear resistance. Said argument has been fully considered but is not persuasive. Current case law does not require a primary reference to recognize/disclose a deficiency in order to render obvious a combination that overcomes said deficiency. Rather, the prior art as a whole must provide motivation for one of ordinary skill in the art to make the proposed modification. In the current situation, Peer teaches high strength is desired in secondary container packages made of paper (col 1, lines 24+) such as the package taught in Cavagna. Furthermore, Peer teaches said high strength can be obtained by applying a film to the outwardly facing surface of a paper package (abstract). Thus, the examiner maintains the position that the prior art provides ample motivation to modify the laminate of Cavagna by adhering thereto the tear resistant film layer of Peer.

With regard to claim 3, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; and a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above. Furthermore, Cavagna in view of Peer teaches that the unbleached cellulosic fibers are selected from the group consisting of unbleached virgin kraft pulp and unbleached

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recycled pulp, as is required by claim 3. Specifically, Peer teaches the unbleached layer comprises kraft pulp or recycled paper pulp (col 5, lines 11-50).

With regards to claim 7, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above.

Furthermore, Cavagna in view of Peer is understood to teach the “adhesive is a barrier for moisture, oil, and odor,” as required by claim 7 because any substance (including the adhesive layer taught in Peer) will restrict moisture, oil, and odor transmission to some extent.

With regards to claim 4, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above.

Furthermore, Cavagna in view of Peer teaches the bottom (unbleached) ply is thicker than the top (bleached) ply. Specifically, Cavagna teaches a paperboard coated with a “thin” paper layer. It is further noted that “paperboard” (the unbleached base ply of Cavagna) is generally understood to refer to cellulose fiber materials that are thicker than paper (see definition of “paperboard” from Merriam Webster’s Collegiate Dictionary).

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With regards to claim 8, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above.

Furthermore, the examiner maintains the claimed publication grade paper is an optional embodiment, which is necessarily present only if a film is not. Since Cavagna in view of Peer comprises a film, said combination reads on said claim.

With regards to claim 10, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above.

Furthermore, the examiner maintains the claimed paper sheet and coating are optional embodiments, which are necessarily present only if a film is not. Since Cavagna in view of Peer comprises a film, said combination reads on said claim. Furthermore, for the claimed embodiments wherein the paper sheet is present, the examiner maintains the position that the laminate taught by Cavagna in view of Peer reads on said invention wherein one of the bleached kraft paper sheets taught in Cavagna reads on the claimed "top ply" and the second kraft paper sheet on the opposite side of the paperboard of the laminate taught in Cavagna reads on the claimed "paper sheet." The examiner notes that the claims do not require said paper sheet to be directly adhered to the top sheet.

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With regards to claim 12, Appellant argues said claim is not obvious over Cavagna in view of Peer because they do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above. Furthermore, Cavagna in view of Peer is understood to teach the claimed film wherein said film is a tear resistant film because Peer teaches the film that is applied should be tear resistant (abstract).

With regards to claim 13, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above. Furthermore, Cavagna in view of Peer teaches said film may be reverse printed (col 3, lines 8+).

With regards to claim 5, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above. Furthermore, the examiner maintains the position that it would have been obvious to one of ordinary skill in the art to increase the brightness of the label paper taught in

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Cavagna in order to enhance the image clarity of the resulting secondary package material.

With regards to claim 11, Appellant argues said claim is not obvious over Cavagna in view of Peer because they do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above.

With regards to claim 14, Appellant argues said claim is not obvious over Cavagna in view of Peer because the references do not disclose a two-ply base, the bottom ply comprising unbleached cellulosic fibers and the top ply comprising bleached or brightened cellulosic fibers; a layer of paper or film attached to the top ply with a layer of adhesive. The examiner respectfully disagrees for the reasons noted above. Furthermore, the examiner maintains the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to pigment the film layer taught by Cavagna in view of Peer. The motivation for doing so would have been to obtain the desired aesthetic effect.

With regards to the rejection of claims 15 and 17-19 as being obvious over Cavagna in view of Peer and further in view of Confer, Appellant argues none of the patents alone or in combination discloses an additional layer of paper or board attached to the bottom ply with an adhesive. The examiner respectfully disagrees. Cavagna in view of Peer is relied upon as above. Specifically, Cavagna teaches a laminate comprising bleached label paper ply/unbleached ply/ bleached label paper ply.

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Furthermore, Confer teaches motivation for applying an adhesive between the inward facing label paper and the paperboard core. In such an embodiment, the inward facing label paper ply is understood to read on the claimed additional layer of paper that is "moisture absorbent." The adhesive is understood act as a moisture barrier layer, be moisture and/or oil resistant, and not to be significantly absorbed by the moisture absorbent layer for the reasons noted in the rejection.

With regard to the rejection of claims 15-20, 22, and 23 as being obvious over Cavagna in view of Peer and further in view of Knudson, Appellant argues none of the references alone or in combination disclose a pair of two-ply base layers each comprised of a bottom ply and a top ply. The examiner respectfully disagrees. Cavagna teaches a three layer laminate comprising a bleached label paper top ply/ unbleached paperboard/bleached label paper top ply. Knudson provides motivation for utilizing a multi-ply paperboard in the place of the paperboard layer taught in Cavagna. The multiply paperboard comprises one ply of high bulk fibers sandwich between at least two plies of conventional papermaking fibers wherein an adhesive is utilized between the layers (abstract, col 5, lines 3-17). When said multiply paperboard is utilized in place of the paperboard core taught in Cavagna, the resulting laminate comprises top ply/ply of conventional papermaking fibers/adhesive/high bulk fibers/adhesive/ply of conventional papermaking fibers/top ply. Said embodiment is understood to read on the claimed laminates of claims 15-20, 22 and 23 for the reasons noted in the rejections above. Appellant provides no further argument why said

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combination fails to render the claimed laminates obvious. Therefore, the rejections are maintained.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Kevin R. Kruer
Patent Examiner-Art Unit 1773

Conferees:



Terrel Morris-Supervisory Patent Examiner



Carol Chaney-SPE, Art Unit 1773